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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 1/30/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nutrition Headquarters, Inc.

Serial Nos. 74/380,556 and 74/380,932

Daniel Kegan of Kegan & Kegan, Ltd. for Nutrition
Headquarters, Inc.

Ronald Sussman, Senior Trademark Examining Attorney, Law
Office 108 (David Shallant, Managing Attorney).

Before Seeherman, Hanak and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On April 16, 1993 Nutrition Headquarters, Inc. (a
Delaware corporation) filed applications to register the
designs shown below for "mail order services for vitamin and
mineral supplements, cosmetics, jewelry, wallets,
housewares, kitchen accessories, health aids, [and] clothing
accessories."

Serial No. 74/380,556

Serial No. 74/380,932

Applicant claims December 31, 1975 as its date of first use and date of first use in commerce with respect to each design.

Applicant describes the designs as follows: "The mark is a vertical arrangement of rectangles" (74/380,556); and "The mark is a vertical arrangement of rectangles with the word FREE enclosed within another rectangle to the side" (74/380,932).¹ In the latter application, applicant has disclaimed the word FREE apart from the mark as shown.

¹ If applicant ultimately prevails herein, it is recommended that applicant amend the description of the mark in each application to clearly set forth what it is applicant is claiming as its

In each case, registration has been finally refused on the ground that the design sought to be registered does not function as a mark for applicant's services (Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. 1051, 1052, and 1145).²

Applicant appealed from the refusals in both applications asserting, in essence, that the configuration designs sought to be registered have acquired distinctiveness and do, in fact, indicate source or origin of the identified services.

Both applicant and the Senior Trademark Examining Attorney briefed the cases and were present at the oral hearing before the Board. Because the issues involved and record in each case are essentially identical, we are rendering our decision as to both applications in a single opinion.³

The Examining Attorney, in each application, argues that, "as used on the specimens of record, the proposed mark

marks. For example, in Serial No. 74/380,556, a more accurate description of the mark would be: "A rectangular grid design in which an order blank and coupons with the names and prices of applicant's vitamin and nutritional supplements appear."

² Although applicant maintains, in its reply brief, that "the various examining attorneys [handling these applications] have impliedly argued [that] applicant's marks are functional", it is clear in each case that the ground for refusal is that the design sought to be registered does not function as a mark.

³ We note that both applicant and the Examining Attorney have treated these cases as consolidated for purposes of filing briefs and presenting argument at oral hearing.

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functions not as an indication of origin, but as an effective arrangement of advertising copy on a page" and as a "helpful cutting guide for consumers who clip coupons." According to the Examining Attorney, "the statement 'Limit one of any size per coupon below!' appearing immediately above the proposed mark on the specimens of record powerfully underscores the failure of applicant's proposed mark to function as a trademark." (Final Office action, pp. 1-2) A photocopy of the specimen submitted in each application is reproduced below in reduced form:

Also, the Examining Attorney argues that a substantial amount of Section 2(f) evidence is required in these cases because the designs are (1) "highly non-distinctive", or commonplace, and (2) buried in applicant's larger advertisement such that customers and prospective customers are unlikely to notice the designs, much less regard them as marks, without exposure to promotion of the designs as source indicators. Finally, the Examining Attorney maintains that applicant's Section 2(f) evidence is inadequate because it pertains to the overall advertisement for applicant's mail order services, and not to the specific designs sought to be registered.

Applicant, on the other hand, contends that by virtue of extensive advertising, the designs sought to be registered are recognized and associated with applicant's mail order services, and thus function as service marks for the services. In each case, applicant submitted the declarations of Michael Slade and Ed Davis, its president and vice-president, respectively.

The declarations are virtually identical and read, in relevant part, that applicant has used the "FREE and Design (Order Form) and Design (Order Form) trademarks" in connection with the mail order promotion and sale of vitamins, nutritional supplements, cosmetics, jewelry, wallets, housewares, kitchen accessories, health aids, and

clothing related products throughout the United States for approximately 15 years; that since 1978 applicant has expended over seventy million dollars in advertising through "the distinctive FREE & Design (Order Form) trademark and Design (Order Form) trademark ad layouts"; and that "the Free & Design (Order Form) and Design (Order Form) trademarks have become distinctive of applicant's mail order services."

Further, in each case, applicant submitted five letters from representatives of publications in which it advertises. According to these advertising representatives, subscribers and readers of their publications recognize applicant because of its continued use of the same advertising layout. Also, the advertising representatives, in follow-up declarations, state that they recognize applicant's "Free and Order Form design layout as original and distinctive" of applicant.

Finally, in each case, applicant submitted fourteen form declarations which read, in relevant part, as follows:

I have worked in or purchased product from the mail order nutritional supplement industry for ____ years, and am well acquainted with the major mail order services and distributors of nutritional supplements and related mail order products.

I recognize the attached layout Design and the layout Free & Design as identifying a mail order services [sic] for vitamin and mineral supplements, cosmetics, jewelry, wallets, housewares, kitchen accessories, health aids and clothing accessories sold by Nutrition Headquarters, Inc.

.

In my opinion the attached layout Design and the attached layout Free & Design are distinctive and are known for high quality products and providing high quality mail order services.

Accompanying each declaration is a photocopy of one of applicant's advertisements. These advertisements are very similar to the specimen reproduced above, the main difference being that the product items and the free gift item depicted in the advertisements vary.

After careful review of the evidence submitted in these applications, we are not persuaded that the designs sought to be registered have become distinctive of applicant's mail order services and serve to distinguish them from the services of others.

There is no question that grid designs are commonly used in advertising. Thus, applicant has a heavy burden to establish that the designs sought to be registered have acquired distinctiveness and would not be considered as mere advertising. See, e.g., *In re Sandberg & Sikorsky Diamond Corporation*, 42 USPQ2d 1544 (TTAB 1997)[In view of the ordinary nature of the gem arrangement designs sought to be registered, applicant had a heavy burden to establish acquired distinctiveness.]; and *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988) and *In re Merrill Lynch, Pierce, Fenner & Smith*,

Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) [The greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness.]

Although applicant's advertising figures are impressive, they do not prove that purchasers recognize the designs sought to be registered as applicant's marks. As the Examining Attorney points out, the designs are simply part of the overall advertising layout used by applicant in promoting its services. While purchasers may well be "attracted" to the designs because they consist of coupons and an order blank, there is no evidence in this record that applicant, in its advertising, emphasized or directed purchasers' attention to the designs in a manner that would cause them to regard the designs as applicant's marks.

Moreover, there are problems with the declarations of the advertising representatives and the individuals "who have worked in or purchased product from the industry." The first problem with these declarations, as the Examining Attorney points out, is that they do not specifically identify what it is that the declarants recognize as applicant's marks. The declarations speak of the "Design layout" and "Free and Design layout", but it is not clear that this reference is to the specific designs applicant has claimed as its marks. As noted previously, the declarations

include copies of applicant's overall advertisement layout and not that portion of the layout which is shown in the drawings of the applications.

Second, even if it were clear from the declarations that the declarants recognize these specific designs as applicant's marks, the declarations would be insufficient to establish that the relevant class of purchasers as a whole recognize the designs as applicant's marks. In this regard, we note that applicant's mail order services contain no restriction as to the class of purchasers. Thus, the relevant class of purchasers of applicant's services includes ordinary consumers. Yet, it is not clear that any of the individuals identified as having "worked in or purchased product from the nutritional industry" are ordinary consumers and not industry personnel.⁴ Thus, neither these declarations nor the declarations of the advertising personnel are probative of how ordinary consumers view applicant's designs. Even if we assume, for purposes herein, that the advertising and industry personnel are purchasers of vitamin and mineral supplements, they constitute a small segment of the consuming public. See, e.g., *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (CAFC 1991) [In determining whether the mark TOUCHLESS

⁴ Indeed, it appears from the occupations provided that most are industry personnel, i.e., account representatives, salespersons, and marketing directors.

had become generic for automobile washing services, the relevant purchasing public consisted of all automobile owners and operators. The court noted that vendors, operators and manufacturers of automobile washing machines constituted but a very small segment of the relevant purchasing public and that evidence of generic use by this segment had limited probative value]. In sum, the declarations are not probative of how the relevant class of purchasers as a whole view applicant's designs.

In reaching our decision, we have not overlooked applicant's reliance on *In re Singer Mfg. Co*, 225 F.2d 939, 118 USPQ 311 (CCPA 1958) [Although the design sought to be registered was used on relatively small labels affixed to containers for the goods, it was nonetheless held to function as a mark]; *In re Haggard Company*, 217 USPQ 81 (TTAB 1982) [Although applicant's "Black Swatch" design (i.e., a design of a black rectangular configuration having a serrated edge along one side thereof) was not inherently distinctive, it was "something more than a common geometric shape or design" and the evidence submitted established that the design had become distinctive of applicant's clothing]; and *In re Post Properties, Inc.*, 227 USPQ 334 (TTAB 1985) [Although the term QUALITY SHOWS was used near text of advertisements, because it was "set off distinctively from the text of the ad copy in extremely large typeface, it was

held to function as a mark for the management and leasing of residential properties for others].

Each of these cases is distinguishable. In *Singer*, the issue was not whether the design sought to be registered had acquired distinctiveness. In *Haggar*, a substantial amount of Section 2(f) evidence was submitted which related to the specific Black Swatch design sought to be registered; and as noted above, in *Post Properties*, the term QUALITY SHOWS was set off distinctively from the text of the advertisement in extremely large typeface.

Finally, applicant relies on a third-party registration, i.e., Registration No. 1,697,934 issued under the provisions of Section 2(f) for a mark consisting of, inter alia, four rectangles forming a large rectangle. While, of course, uniform treatment under the Trademark Act is highly desirable, our task on this appeal, based upon the factual record before us, is to determine whether applicant's mark is registrable. As the Board has often stated, each case must be decided on its own set of facts. See, e.g., *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991) and cases cited therein. We are not privy to the file record of this third-party registration and thus have no way of knowing the reasons for its allowance.

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Decision: The refusals to register in application
Serial Nos. 74/380,556 and 74/380,932 are affirmed.

E. J. Seeherman

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board